

REMARKS

Claims 1, 3, 5-11 and 13-23 are pending and at issue in the application with claims 1, 11 and 17 being independent claims. No claims have been amended, added or cancelled. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

The applicants respectfully traverse the rejections of claims 1, 3, 5-11 and 13-23 under 35 U.S.C. §103 as unpatentable over Keyes, IV et al. (U.S. Patent Application Publication No. 2006/0142875) in view of Esler (U.S. Patent Application Publication No. 2003/0135244).

As an initial matter, the action fails to procedurally present a *prima facie* case of obviousness of claim 23, because the action has failed to address claim 23. In particular, while the action generally states that claims 1, 3, 5-11 and 13-23 are unpatentable over Keyes, IV et al. in view of Esler on page 2, no reasons are actually provided for rejecting claim 23 as required by 35 U.S.C. §132 (see also *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007); MPEP 2142). A conclusory statement of obviousness alone is not sufficient to provide a *prima facie* case of obviousness, yet a conclusory statement that claim 23 is obvious is the only reference to claim 23 provided in the action. At no point in the action is claim 23, much less the language of claim 23, actually addressed or reasons given for its rejection.

For similar reasons, the action fails to present a *prima facie* case of obviousness of claims 14, 18 and 19-21. While the action initially appears to address these claims, it is clear that the language of the claims is not addressed, and, hence, the claims themselves and the corresponding features have not been addressed or reasons given for their rejection. In particular, the action appears to paraphrase language from claims 1, 3, 11, 13 and 17 (“wherein the memory device is further adapted to, store sensor data received by the computer at time prior to the occurrence of the predetermined process event and subsequent to the occurrence of the predetermined process event” when rejecting claim 14, but does not actually address the language of claim 14 (“wherein the first field device detects the occurrence of the predetermined process event and communicates the occurrence of the predetermined process event to at least a second field device to store data on a second memory device associated with the second field device”). Likewise, the action appears to

paraphrase language from claims 1, 11 and 17 (“wherein the memory device is further adapted to, store sensor data received by the computer at time prior to the occurrence of the predetermined process event”) when rejecting claim 18, but does not actually address the language of claim 18 (“wherein the predetermined process event is the occurrence of a sensed parameter being out of a predetermined range”). Further, the action appears to paraphrase language from claims 9 and 15 (“wherein the predetermined process event is an excessive travel deviation of a valve element”) when rejecting claims 19 and 20, but does not actually address the language of claim 19 (“wherein the predetermined process event is the failure of a sensor”) or claim 21 (“wherein the predetermined process event is a process variable change”). Still further, the action appears to paraphrase language from claims 10 and 16 (“wherein the predetermined process event is a sensor signal, representing a sensed valve parameter, crossing a cutoff point”) when rejecting claim 20, but does not actually address the language of claim 20 (“wherein the predetermined process event is a component failure”).

Accordingly, the present action does not present a *prima facie* case of obviousness of claims 14, 18, 19-21 and 23, and, therefore, the action cannot be made final. It is impossible for the applicants to judge the propriety of continuing the prosecution of these claims, as provided by 35 U.S.C. §132, when it is evident from the action that these claims have not been addressed. The applicants are entitled to examination on the merits of each of the claims as reflected in any action issued by the Patent Office. As such, the applicants respectfully request that prosecution be reopened in order to address the merits of claims 14, 18, 19-21 and 23.

Turning to the rejections, each of claims 1, 3, 5-11 and 13-23 recites a system, method or device that detects the occurrence of a predetermined process event and stores sensor data received from a sensor associated with a field device if the occurrence of the predetermined process event is detected. The stored sensor data includes sensor data collected prior to the occurrence of the predetermined process event. Simply put, the action does not provide a *prima facie* case of obviousness because neither Keyes, IV et al. nor Esler discloses or suggests each of the features of the claims, because Esler is not analogous art and because the asserted rationale is insufficient to combine Keyes, IV et al. and Esler.

In particular, the action acknowledges that Keyes, IV et al. does not disclose storing sensor data if the occurrence of the predetermined process event is detected. Indeed, as shown in the applicants’ previous response of January 23, 2008, Keyes, IV et al. does not

disclose or suggest storing sensor data in the memories 18 of the device 10 at all, much less storing sensor data from a sensor associated with a field device or process control apparatus in the memories 18 if the occurrence of a predetermined process event is detected. Esler fails to make up for this lack of disclosure. While Esler discloses storing contents of a buffer 22 to a memory 18 if an error event is triggered, the contents of the buffer 22 do not relate to sensor data from a sensor associated with a field device or process control apparatus, and the error event does not relate to a predetermined process event. Instead, the contents of the buffer 22 in Esler are electrogram (EGM) signals from sensing electrodes attached to a patient's heart (see paragraphs [0022], [0026]) and event markers. EGM signals of a patient's heart are clearly not sensor data from a sensor associated with a *field device or process control apparatus*. Likewise, the event markers are not sensor data from a sensor associated with a field device or process control apparatus. The event markers of Esler are simply indications of events that may or have occurred, but do not relate to data from the sensing electrodes, much less a sensor associated with a field device or process control apparatus.

In addition, while the event markers indicate the occurrence of an error event in a tissue stimulating medical implant, the event markers certainly do not pertain to a predetermined *process* event in a *process control system* or *field device*. Accordingly, whereas Keyes, IV et al. does not disclose storing sensor data from a sensor associated with a field device or process control apparatus if the occurrence of the predetermined process event is detected, Esler also does not disclose storing sensor data from a sensor associated with a field device or process control apparatus if the occurrence of the predetermined process event is detected. It is clear that a *prima facie* case of obviousness cannot be maintained if the prior art does not disclose or suggest each of the claimed features.

Further, Esler is not analogous art. As required by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1397 (2007), "any need or problem known *in the field of endeavor* at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." (emphasis added) (see also MPEP 2141.01(I)). Indeed, it has long been held that "[in] order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be *in the field of applicant's endeavor* or, if not, then be reasonably pertinent to *the particular problem with which the inventor was concerned*." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (emphasis added).

In one respect, the fields of endeavor of the present application and Esler are vastly different. Each of claims 1, 3, 5-11 and 13-23 is directed to a diagnostic system for a field device in a process control apparatus, a method of monitoring the performance of a process control system including a field device or a field device for a process control apparatus. It should be clear from the applicants' disclosure, that the field of endeavor relates to process control systems and field devices, such as turbine bypass valves and compressor anti-surge valves found in chemical, petroleum or other industrial processes (see e.g., paragraphs [0001]-[0009], [0017]-[0028], Figs. 1 and 2). By contrast, Esler is directed to an electronic medical implant for stimulating tissue in a patient, such as pacemakers (see Abstract, paragraphs [0001]-[0017]). The two fields of endeavor could not be more different and nonanalogous. Merely because Esler may relate generally to trigger data storage does not mean that a tissue stimulating medical implant is in the same field of the applicants' endeavor, such as field devices and process control apparatus. See *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (A memory module for an industrial controller not in the same field of endeavor as a memory module for personal computers). One of ordinary skill in the art simply would not expect to solve a problem associated with field devices in a process control system by considering a reference dealing with tissue stimulating medical implants.

In another respect, each of claims 1, 3, 5-11 and 13-23 addresses a problem different from that of Esler. Whereas Esler addresses the problem of recording sensor data of a patient's heart and error event markers in response to detecting the error event marker, the system, method or apparatus of claims 1, 3, 5-11 and 13-23 addresses the problem of storing sensor data from a sensor associated with a field device or process control apparatus in response to a predetermined process event. It is an oversimplification to view the two as simply relating to the problem of storing data in response to a trigger, as seems to have been done in the action. Accordingly, even aside from the fact that Esler and claims 1, 3, 5-11 and 13-23 are in different fields of endeavor, one of ordinary skill in the art would not find storing patient heart sensor data and error event markers in a tissue stimulating medical implant relevant to a problem involving storing field device sensor data in a process control system/apparatus in response to the occurrence of a predetermined process event. Accordingly, Esler is not analogous art with respect to claims 1, 3, 5-11 and 13-23, and, for this reason, the action has not presented a *prima facie* case of obviousness.

Still further, the asserted rationale to combine Keyes, IV et al. and Esler is not sufficient to establish a *prima facie* case of obviousness, because one of ordinary skill in the art would not use the asserted rationale to combine Keyes, IV et al. and Esler. As required by the Federal Circuit, “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). This requirement was upheld by the Supreme Court in *KSR* (see 82 USPQ2d at 1396). (See also MPEP 2142). In short, when formulating an obviousness rejection based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

The action essentially asserts that conservation of processing power and battery power would cause one of ordinary skill in the art to combine Esler with Keyes, IV et al. This is incorrect. The device of Esler is concerned with recording fault history information in a tissue stimulating medical implant, where fault history information was not previously recorded. In other words, Esler, at a minimum, provides an additional function to tissue stimulating medical implants. Providing additional functionality *increases* the use of processing and battery power. To assert that providing additional data storage as taught by Esler would conserve processing and battery power is simply illogical. If one of ordinary skill in the art wanted to conserve processing and battery power, one of ordinary skill in the art would likely remove, minimize or increase the efficiency of existing functionality, not add additional functionality. Accordingly, the asserted rationale for combining Keyes, IV et al. and Esler does not support the action’s conclusion of obviousness, and, for this additional reason, the action has not presented a *prima facie* case of obviousness.

As a final matter, the applicants note that Keyes, IV et al. is only available as prior art under 35 U.S.C. §102(e). In particular, Keyes, IV et al. claims priority to U.S. Patent No. 7,035,773 which was filed on March 6, 2002, published as U.S. Patent Application Publication No. 2003/0171827 on September 11, 2003 and patented on April 25, 2006. U.S. Patent No. 7,035,773 is only available as prior art under 35 U.S.C. §102(e), and, as a result, Keyes, IV et al. is only available as prior art under 35 U.S.C. §102(e).

Keyes, IV et al. and the instant application were commonly owned at the time of the invention of the claimed subject matter. The assignment of Keyes, IV et al. is by virtue of the assignment of the parent application to Fisher Rosemount Systems, Inc., which was recorded on August 7, 2002, and can be found at Reel 013159, Frame 0128. The assignment of the instant application to Fisher Controls International, LLC was recorded on January, 2, 2004, and can be found at Reel 014848, Frame 0413. Both Fisher Rosemount Systems, Inc. and Fisher Controls International, LLC are commonly owned by Emerson Process Management. The applicants are currently reviewing documentation to demonstrate this common ownership of Fisher Rosemount Systems, Inc. and Fisher Controls International, LLC at the time of the invention of the claimed subject matter, and hence, the common ownership of Keyes, IV et al. and the instant application. Accordingly, the applicants reserve the right to file a Supplemental Response with a Statement of Common Ownership to remove Keyes, IV et al. as a prior art reference under 35 U.S.C. §103(c).

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested. Three (3) independent claims remain in the application as previously paid for, and twenty (20) total claims remain in the application as previously paid for. The applicants believe no fee is due. However, the commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 13-2855. Should the examiner wish to discuss the foregoing, or any matter of form, in an effort to advance this application towards allowance, the examiner is urged to telephone the undersigned at the indicated number.

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Respectfully submitted,

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